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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1940.

No. 277

THE AUTOMATIC DEVICES CORPORATION,
Petitioner,

vs.

SINKO TOOL & MANUFACTURING COMPANY,
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Supplemental Statement of the Case.

In petitioner's "Summary Statement of the Matter Involved" nothing is said of defendant's alleged abandonment of the defense of invalidity of the Mead patent in the District Court, although on page 2 the first question presented assumes such abandonment to be a fact. Respondent emphatically denies that it has at any time waived the defense of invalidity.

There is no conflict between the decision of the Court of Appeals for the Seventh Circuit concerning the patents

in suit and the decision of the Court in any other Circuit. As a matter of fact, the District Court of Connecticut (Second Circuit) in the case of *The Automatic Devices Corporation* v. *The Cuno Engineering Corporation*, in an opinion dated June 7, 1940, also held that the same claims in Mead Patent No. 1,736,544 were not infringed, and that claims 3 and 20 of the same Cohen Patent No. 2,140,311 are invalid for lack of invention.

Opinions of the Courts Below.

Petitioner is in error in its statement that the opinion of the District Court is not reported. The first opinion, *The Automatic Devices Corporation* v. *Sinko Tool and Mfg. Co.*, appears in 42 U. S. P. Q. 261 The uncorrected opinion of the Court of Appeals appears in the advance sheets of 45 U. S. P. Q. 394, and the corrected opinion in the advance sheets of 112 F. (2d) 335.

A decision of the District Court of Connecticut, denying a preliminary injunction on the Mead patent, is entitled *The Automatic Devices Corp.* v. *Cuno Engineering Corp.*, 43 U. S. P. Q. 68. The last opinion of that court, dated June 7, 1940, holding the Mead patent not infringed and the Cohen patent invalid is not yet reported.

ARGUMENT.

Petitioner in its first question states as a "fact" that respondent *abandoned* the defense of invalidity of the Mead patent. Respondent emphatically denies that allegation. Petitioner was unable to persuade either the District Court or the Court of Appeals that there had been such an abandonment.

Petitioner bases its argument solely on defendant's remarks accompanying the petition for a rehearing in the District Court. (Rec. 244.) Defendant there pointed out that, in the Court's original memorandum, it was stated that the defense on the three patents was on validity, alone, and no mention was made of the defense of non-infringement. As will be seen from reading the entire petition for a rehearing (Rec. 242), it was no abandonment of the defense of invalidity, but it merely called the attention of the District Court to the fact that defendant's "principal and primary defense as to the Mead patent" was non-infringement and that in our *argument* we had not emphasized the defense of invalidity. Surely the fact that counsel chooses to urge one defense more strongly than the other is no abandonment of a defense which had not been emphasized.

Paragraphs 12 to 16 and 18, inclusive, of the answer (Rec. 8-10) set forth the defense of invalidity, and the notice of appeal (Rec. 265) states that defendant appeals from the holding that the Mead patent is valid and has been infringed by defendant.

The District Court fully understood defendant's position and accordingly changed the first paragraph of the memorandum decision (Rec. 255) to read, "Defendant answered denying the validity of the patent and denying infringement". Petitioner raised the same point at the oral argu-

ment before the Court of Appeals, and again in its petition for a rehearing before that Court (Rec. 530). The Court of Appeals could not find anything in the record to show abandonment of the defense. There is no question of law involved on this point, but it is merely one of fact which has been decided adversely to the petitioner.

Broadening of Specification and Claims.

All three Courts, which have considered the Cohen Patent No. 2,140,311, have held the claims relied upon are invalid for lack of invention. This was the holding of the District Court, the Court of Appeals for the Seventh Circuit, and the District Court of Connecticut.

The Court of Appeals for the Seventh Circuit pointed out another good and sufficient ground for holding the Cohen claims bad. The original claims were all quite narrow. After seeing defendant's device, broadening statements were added to the specification and broader claims were added to cover defendant's arrangement which was not shown or originally described by Cohen. As pointed out in the opinion of the Court of Appeals, defendant came on the market with its device in June, 1938 (Rec. 515):

> "Shortly thereafter Cohen saw and studied it, and afterwards in September, 1938, while this suit was pending, he added to his pending application claims 14 to 26 inclusive, as they now appear. On November 19, 1938, while the present suit was pending, Cohen substituted a new preamble to his specification, in which he gave the purposes and objects of the invention, and for the first time recited that his thermostatic switch could be used in either the plug or the socket parts of the lighter, and that it would no longer be necessary to match the parts, and pointed out that the parts were in co-axial alignment.
>
> This addition of a new preamble and claims seems to have been an effort to meet the differences, if any, between Mead and the accused device, and such prac-

> tice seems not to be countenanced by either the statutes or the decisions. See *Railway Co.* v. *Sayles*, 97 U. S. 554; *Hobbs* v. *Beach*, 180 U. S. 383; *General Electric Co.* v. *Sangamo Electric Co.*, 174 F. 246. For this reason we think the District Court did not err in holding the claims of the Cohen patent invalid. We are also of opinion that this patent is invalid for lack of novelty."

This is not a new point of law, but had the Court of Appeals found the patent valid and infringed under such circumstances we have no doubt that this Court would have granted a writ of certiorari. As this Court stated in *Railway* v. *Sayles*, 97 U. S. 554:

> "The Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has in the meantime gone into public use."

In *Hobbs* v. *Beach*, 180 U. S. 383, the patentee made a very trifling amendment to the claims of its original application, an amendment so natural and normal that this Court held that it was a perfectly proper amendment in that case, but that it would not have sustained such an amendment had it been made after the defendant entered the field, particularly if made in view of defendant's device.

That statement by this Court was not *dictum* but was a necessary distinction from the prior decision of *Railway* v. *Sayles*, which was cited.

An examination of the file wrapper of the Beach patent in that case shows precisely the amendment which this Court said was a legal amendment because it was made *before* the defendant entered the field but which would have been an illegal amendment if made *after* the defendant entered the field.

The same result was reached by the Court of Appeals for the Seventh Circuit in *General Electric Co.* v. *Sangamo Electric Co.*, 174 Fed. 246. The last mentioned case was cited with approval by this Court in *Powers-Kennedy Corp.* v. *Concrete M. & C. Co.*, 282 U. S. 175, in which this Court expressed extreme disapproval of the practice of broadening applications to catch new ideas which had entered the field.

Corrected Opinion.

The opinion of the Court of Appeals (Rec. 502, 517) contains careful and precise descriptions of many of the complicated structures involved. One slight mechanical error was noted in the original draft of the opinion and this was called to the attention of the Court in plaintiff's petition for rehearing. After carefully reviewing the matter, the language was corrected by the Court, showing that it fully understood the construction of the Cohen patent, and that the slight change in the wording only substantiated the Court's original conclusions.

Infringement.

Under "Point 4" of its brief petitioner merely reargues its position on the question of infringement. To go into this involves a careful review of the claims, prior art, and complicated structures. Briefly, the claims recite that the "heater member" moves; and in defendant's device the "heater" or igniting coil does not move. Only defendant's push button switch in the plug moves.

This matter is so completely set forth in the opinion of the Court of Appeals that we do not think it necessary for us to burden this Court with further discussion.

CONCLUSION.

In view of the fact that there is no conflict between the decisions of the Courts in the two Circuits which have considered these patents, and because there is no new question of law or public interest involved, it is submitted that The Automatic Devices Corporation's petition in this case should be denied.

Respectfully submitted,

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Chicago, Illinois,
August 1, 1940.

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